

# **Appendix A**



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,743	02/23/2004	Dany Sylvain	7000-272	2454
27820 7590 03/17/2009 WITHROW & TERRANOVA, P.L.L.C. 100 REGENCY FOREST DRIVE SUITE 160 CARY, NC 27518			EXAMINER KIM, WESLEY LEO	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 03/17/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

10/17/2009

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10784,743		SYLVAIN, DANY	
	<b>Examiner</b>		<b>Art Unit</b>	
	WESLEY KIM		2617	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 30-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 30-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/22/08</u>  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Response to Amendment***

1. This Office Action is in response to Amendment filed 12/12/08.
  - Claims 1-15 and 30-44 are pending in the Current Office Action.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-15 and 30-44 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6-8, 11-15, 30-32, 35-37, and 40-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Steward et al (US 6373828 B1).

**Regarding Claims 1 and 30,** Steward teaches transitioning a call with a mobile terminal from a cellular connection to a local wireless connection (Col.11:lines 9-14), the system comprising: a) at least one communication interface (Fig.4: signaling interface 350); b) a control system (Fig.4:312 and Col.12:lines 35-38, the computing platform 312 is the control system) associated with the at least one communication interface (Fig.4:350, connected to the control system so it is associated with the interface) and adapted to:

i) receive an inter-switch handoff request from a wireless switch supporting a call to the mobile terminal over a cellular access network (Col.12:lines 35-38), the call comprising a first connection from the wireless switch (Fig.4:MSC 317) to the mobile terminal and a second connection between the wireless switch and an entity (Col.11:lines 9-14 and Col.5:lines 60-66, mobile moves from the cellular network to the local wireless connection so there is a pre-established first connection from the mobile station to the MSC 317 and since the mobile has a call in progress there is a second connection to the other phone (i.e. entity)); ii) effect establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports local wireless communications with the mobile terminal (Col.13:lines 19-25 and Fig.8:623, terminal adaptor is the base station element 306 and handover is complete so a new connection is established); and iii) provide an inter-switch handoff instruction to the wireless switch (i.e. MSC 317) to connect the second connection and the inter-switch handoff connection to effect handoff of the call from the cellular connection to the local wireless connection (Col.13:lines 25-39 and Fig.8:627 and 629, computing platform forwards a mobile station (i.e. inter-switch handoff instruction) to the msc).

**Regarding Claims 2 and 31**, Steward further teaches the inter-switch handoff connection is established in part between a wireline switch and the terminal adaptor (Col.13:lines 1-6, wireline switch 316 and terminal adaptor 306).

**Regarding Claims 3 and 32**, Steward further teaches the inter-switch handoff request is received and the inter-switch handoff instruction is provided using

a cellular protocol (Col.12:lines 35-38, IS-41 is an AMPS cellular protocol) while the establishment of the inter-switch handoff connection is effected using a public switched telephone network-based protocol (Col.9:lines 53-55 and Col.4:lines 26-43, a mobile station in the generic network communicates using a PSTN based protocol).

**Regarding Claims 6 and 35,** Steward further teaches inter-switch handoff connection is established using a directory number associated with the mobile terminal when supported via the terminal adaptor (Col.12:lines 46-55, TDN is a Directory Number)

**Regarding Claims 7 and 36,** Steward further teaches the inter-switch connection is established in part over a packet network (Col.4:lines 51, use of internet protocols indicates a packet network) operatively coupled to the terminal adaptor (Fig.4:306) (Col.4:lines 51, Internet Protocol).

**Regarding Claims 8 and 37,** Steward further teaches the inter-switch handoff request is received and the inter-switch handoff instruction is provided using a cellular protocol (Col.12:lines 35-38, IS-41 is an AMPS cellular protocol) while the establishment of the inter-switch handoff connection is effected using a packet-based communication session protocol (Col.4:lines 51, signal 355 in Fig.4 can be an IP connection so the establishment of a connection would be IP based).

**Regarding Claims 11 and 40,** Steward teaches providing a inter-switch handoff message to the wireless switch to confirm handoff to the inter-switch handoff connection (Col.13:lines 25-39 and Fig.8:627 and 629, computing platform forwards

a mobile station (i.e. release message), to the MSC 317 to confirm handoff of the call from the cellular connection to the local wireless connection).

**Regarding Claims 12 and 41,** Steward teaches the inter-switch handoff request comprises a cell site identifier to which the wireless switch is attempting to handoff the call, the cell site identifier corresponding to the terminal adaptor (Col.12:lines 24-26).

**Regarding Claims 13-14 and 42-43,** Steward teaches the cell site identifier is provided to and then accessed by the wireless switch by/from the mobile terminal (Col.12:lines 12-26 and 35-44, the target cell identifier is provided by the mobile terminal moving around and the determination by a base station elements that a handover request needs to be sent and accessed by platform 312).

**Regarding Claims 15 and 44,** Steward teaches providing the cell site identifier to the wireless switch (Col.12:lines 21-26).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4-5, 9-10, 33-34, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steward et al (US 6373828 B1) in view of Koistinen (US 7136375 B1).

**Regarding Claims 4, 9, 33, and 38, Steward teaches all the limitations as recited in claim 2, and Steward further teaches of the utilization of internet protocols at the wireline switch side, which indicates the presence of a packet network (Col.4:lines 51) and Steward further teaches a call initiation request (i.e. handover request) sent from a cellular network to a generic network (Col.11:lines 9-14), however **Steward does not expressly teach** first and second media gateways, the first media gateway connected to the wireless switch via a cellular-based trunk and the second media gateway connected to the wireline switch via a public switched telephone network-based trunk, the method further comprising sending call initiation messages to the first and second media gateways and the wireline switch to establish the inter-switch handoff connection.**

**Koistinen teaches first and second media gateways (Fig.3, gateway 304 and gateway 306), the first media gateway connected to the wireless switch via a cellular-based trunk (Fig.3, trunk between 301 and 304) and the second media gateway connected to the wireline switch via a public switched telephone network-based trunk (Fig.3 and Col.4:lines 1-4, trunk between 305 (i.e. PSTN) and 306).**

**Therefore, it would have been obvious to modify Steward with Koistinen at the time of the invention to provide a network element to connect the various networks to one another to provide interoperability so that the user of a mobile device is able to access various networks for the purposes of making a phone call and sending email while on the move with a single device as opposed to carrying around multiple devices, i.e. phones and laptops.**



**Regarding Claims 5, 10, 34, and 39**, Koistinen further teaches that gateways, i.e. the first and second, facilitate interworking between the cellular-based trunk and the public switched telephone network-based trunk over a packet network (Col.3:lines 26-31).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WESLEY L. KIM whose telephone number is (571)272-7867. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/  
Supervisory Patent Examiner, Art Unit 2617

/Wesley L Kim/  
Examiner, Art Unit

<b>Notice of References Cited</b>	Application/Control No. 10/784,743	Applicant(s)/Patent Under Reexamination SYLVAIN, DANY	
	Examiner WESLEY KIM	Art Unit 2617	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,373,828	04-2002	Stewart et al.	370/331
*	B	US-7,136,375	11-2006	Koistinen, Tommi	370/352
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Not for submission under 37 CFR 1.99)	Application Number		10784743	
	Filing Date		2004-02-23	
	First Named Inventor	Dany Sylvain		
	Art Unit	2617		
	Examiner Name	Wesley Leo Kim		
	Attorney Docket Number	7000-272		

## U.S.PATENTS

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Examiner Initial*	Cite No	Patent Number	Kind Code <sup>1</sup>	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
	1	5579375		1996-11-26	Ginter	
	2	5901359		1999-05-04	Malmstrom	

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## U.S.PATENT APPLICATION PUBLICATIONS

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	1	20020061744	A1	2002-05-23	Hamalainen et al.	
	2	20030134650	A1	2003-07-17	Sundar et al.	

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	1							<input type="checkbox"/>

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**  
( Not for submission under 37 CFR 1.99)

Application Number	10784743
Filing Date	2004-02-23
First Named Inventor	Dany Sylvain
Art Unit	2617
Examiner Name	Wesley Leo Kim
Attorney Docket Number	7000-272

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**NON-PATENT LITERATURE DOCUMENTS**

Examiner Initials*	Cite No	include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>5</sup>
	1		<input type="checkbox"/>

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**EXAMINER SIGNATURE**

Examiner Signature	/Wesley Kim/	Date Considered	03/13/2009
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> See Kind Codes of USPTO Patent Documents at [www.USPTO.GOV](http://www.USPTO.GOV) or MPEP 801.04. <sup>2</sup> Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>3</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>4</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>5</sup> Applicant is to place a check mark here if English language translation is attached.